Our Ref: 3350-05E
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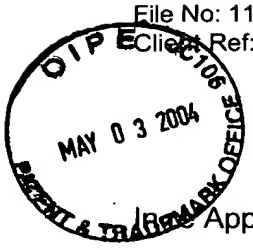
PATENT

#18



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	
KITCHEN, et al.	:	
	:	Group Art Unit:3622
Application No:	:	
09/867,587	:	Examiner: R. Alverez
	:	
Filed:	:	
May 31, 2001	:	

For: BILL AVAILABILITY NOTIFICATION AND BILLING INFORMATION REQUEST

APPEAL BRIEF

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted (in triplicate) in support of the Notice of Appeal filed March 3, 2004 of the finally rejected claims as set forth in the final Official Action dated November 3, 2003.

I. REAL PARTY IN INTEREST

CheckFree Corporation, Reel 9284, Frame 0159.

II. RELATED APPEALS AND INTERFERENCES

None.

III. STATUS OF CLAIMS

Claims 34-53 are pending in this application, of which claims 34, 40, 43, 50, 51, and 52 are independent. Each of claims 34-53 is subject to appeal.

IV. STATUS OF AMENDMENTS

A Preliminary Amendment was filed on May 31, 2001 and has been entered. A Supplemental Preliminary Amendment was filed on March 28, 2002 and has been entered. An Amendment was filed on August 13, 2003 and has been entered. An Amendment After Final was filed on February 3, 2004 and has not been entered.

V. SUMMARY OF INVENTION

The invention will be summarized with reference to the preferred embodiment(s)/implementations(s) shown in Figures 1, 2, 2A, 2B, 7, 8, and 9A and described in the related specification text on pages 11, 12, 13, 15, 16, 24, 25, and 27.

In a preferred embodiment of the invention of independent claim 34 a method for presenting billing information includes transmitting a notice according to an e-mail protocol via a network 100, that indicates availability of billing information (see, for

example, page 13, line 25, through page 14, line 2; and page 24, lines 2-5), transmitting a request according to a protocol other than an e-mail protocol via network 100 in response to a receipt of the notice (see, for example, page 15, lines 18-16; and page 24, lines 5-7), and transmitting at least a portion of the billing information via the network 100 in response to the request (see, for example, page 15, line 32, through page 16, line 2, and page 24, lines 7-13).

In a preferred embodiment of the invention of independent claim 40 a method for presenting billing information includes transmitting an e-mail notice via network 100 indicating availability of billing information (see, for example, page 13, line 25, through page 14, line 2; and page 24, lines 2-5), transmitting an e-mail request, via network 100, to receive the billing information in response to the notice (see, for example, page 15 lines 23-24), and transmitting, via the network, at least a portion of the billing information in response to the request (see, for example, page 15, line 32, through page 16, line 2, and page 24, lines 7-13).

In a preferred embodiment of the invention of independent claim 43 a method for presenting billing information includes transmitting, via network 100 and according to a network protocol other than e-mail, a notice indicating availability of billing information (see, for example, page 25, lines 27-29), transmitting, via network 100 and also according to a network protocol other than e-mail, a request to receive the billing information (see, for example, page 25, lines 31-34), and transmitting via network 100 at least a portion of the billing information in response to receipt of the request (see, for

example, page 15, line 32, through page 16, line 2, and page 24, lines 7-13).

In a preferred embodiment of the invention of independent claim 50 a bill presentment network 100 includes a first network server (e.g. a CF processor 410) and a second network server 410. The first network server 410 transmits, via an e-mail protocol, a notice to a payer (e.g. payor station 120a) indicating availability of a bill. The second network server 410 receives from the payer 120a, via a protocol other than e-mail, a request to receive the bill. The request is transmitted in response to receipt of the notice. The bill is then transmitted to the payer 120a in response to receipt of the request.

In a preferred embodiment of the invention of independent claim 51 a system for bill presentment includes a memory 420 and a processor 410. The memory 420 stores billing information (e.g., normalized billing 420d and/or bill summary information 420e). The processor 410 transmits a notice to a payer 120a, via e-mail, indicating availability of a bill, and receives a request from the payer 120a via e-mail for the available bill. The request is transmitted in response to receipt of the notice, and the bill is transmitted to the payer 120a in response to receipt of the request.

In a preferred embodiment of the invention of independent claim 52 a system for bill presentment includes a memory 420 and at least one processor 410. The memory 420 stores billing information 420d and/or 420e. The at least one processor 410 transmits, via a network protocol other than an e-mail protocol, a notice to a payer 120a indicating availability of billing information 420d and/or 420e, and receives, via a

network protocol other than an e-mail protocol, a request from the payer 120a to receive the billing information 420d and/or 420e. The request is transmitted in response to receipt of the notice, and the bill is transmitted to the payer in response to receipt of the request.

As recited in dependent claims 35, 41 and 44, the billing information is formatted for presentation in response to receipt of the request (see, for example, page 16, lines 2-9).

As recited in dependent claims 36, 42, and 45, the billing information is formatted for presentation prior to transmission of the notice and then stored. In this aspect, the transmitted billing information is the stored formatted billing information (see, for example, page 16, lines 10-17).

As recited in dependent claims 37 and 46, the notice includes information indicating a location of the available billing information on the network 100 (see, for example, page 19, lines 25-30; and page 25, lines 27-34).

As recited in dependent claims 38 and 47 the location information is a hyper-link that is selected to cause transmission of the request (see, for example, page 25, lines 27-34).

As recited in dependent claims 39 and 48, the hyper-link is an icon (see, for example, page 15, lines 27-31).

As recited in dependent claims 49 and 53, the notice and the request are each transmitted according to a same network protocol other than e-mail (see, for example,

page 25, lines 31-34).

VI. ISSUES

Whether claims 34-38, 40-47, and 49-53 are anticipated under 35 U.S.C. § 102(b) by Hogan (U.S. Patent No. 5,699,528).

Whether claims 39 and 48 are obvious, under 35 U.S.C. § 103(a), over Hogan in view of Bezos (U.S. Patent No. 6,029,141).

VII. BRIEF DESCRIPTION OF THE REFERENCES

HOGAN

Hogan discloses two embodiments of an electronic bill presentment service. In both embodiments, a bill image is received from a biller and formatted for presentation (see, for example, column 4, lines 53-67, column 5, lines 53-57, and column 9, lines 50-53). Hogan teaches that a bill image received from a biller is formatted by the bill service for presentment as soon as that bill image is received (see column 5, lines 53-57, and column 9, lines 50-54). In Hogan, communication with a subscriber, no matter the embodiment, is via a single server (detail 160).

In the first embodiment, formatted billing information is stored for eventual access by a subscriber. In other words, a subscriber retrieves the stored billing information from the bill service via the World Wide Web (see, for example, column 2, lines 32-35). In the second embodiment, the formatted billing information is transmitted to a subscriber as an

e-mail message by the bill service upon completion of the formatting (see, for example, column 2, lines 48-50; and column 9, lines 7-19 and 50-54).

In the first embodiment of Hogan, an e-mail message or regular mail message informing a subscriber of pending bill due date is transmitted to a subscriber only if each of two conditions have been met. This e-mail will only be sent if the subscriber has not logged on to the bill service and the bill is due within a predetermined period of time (see, for example, column 5, lines 53-61). In the second embodiment of Hogan, a notice of a pending bill due date is sent to a subscriber via regular mail if the bill has previously been electronically delivered via e-mail, payment has not been made, and the bill is sue within a certain time frame (see, for example, column 10, lines 9-12).

BEZOS

Bezos is directed to selling goods via the Internet (see, for example, Figure 1). Bezos teaches a user selectable icon to link to a merchant's Web site to retrieve information about and/or purchase a good (see, for example, column 11, lines 47-52)

VIII. THE REJECTION

In a first substantive Official Action issued on May 13, 2003, claims 49 and 53 stood rejected as being indefinite under 35 U.S.C. §112, second paragraph, because of a lack of antecedent basis. Also, claims 34-38, 40-47, and 49-53 stood rejected under 35 U.S.C.

§102(b) as anticipated by Hogan, and claims 39 and 48 stood rejected under 35 U.S.C. § 103(a) as obvious over Hogan in view of Bezos.

In the final Official Action issued November 3, 2003, the indefininess rejection was withdrawn in view of the Amendment of August 13, 2003. The art rejections were maintained, with the arguments from the May 13, 2003 Official Action directly copied into the final rejection. Furthermore, the Examiner failed to respond to many of the August 13, 2003 traversal arguments.

In the Advisory Action issued on February 17, 2004, the February 3, 2004 Amendment After Final was denied entry, notwithstanding that only two independent claims were amended. Furthermore, the Examiner failed to consider any of the traversal arguments of the February 3, 2004 filing.

IX. GROUPING OF CLAIMS

Claims 34-53 are pending in this application. Claims 34-53 are finally rejected and subject to this appeal.

Rejected claims 34, 40, 43, 50, 1, and 52 are independent. Accordingly the various claimed embodiments/implementations of the invention are defined within groupings of claims (i) 34-39, (ii) 40-42, (iii) 43-49, (iv) 50, (v) 51, and (vi) 52-53. However, the claims of each group do not stand or fall together. Each of claims 34, 35, 37-41, 43, 44, and 46-48, 50-52 recite features which form an independent basis for allowance. Hence, claims 34 and 36 stand and fall together; claims 40 and 42 stand and

fall together; claims 43, 45, and 49 stand and fall together; claims 52 and 53 stand and fall together; and each of claims 35, 37-39, 41, 44, 46, 48, 50, and 51 stands and falls alone.

X. ARGUMENT

Claims 34-38, 40-47, and 49-53 stand finally rejected under 35 U.S.C. § 102(b) as anticipated by Hogan. Claims 39 and 48 stand finally rejected as obvious over Hogan in view of Bezos. Appellants respectfully traverse the rejections based on the prior art applied against the claims now pending on appeal.

As discussed below in detail, it is respectfully submitted that the Examiner has not met the burden of proof in establishing that the appealed claims are anticipated, has not met the burden of proof in establishing that the appealed claims are obvious, has failed to provide the required factual basis and reasonable rationale for the prior art rejections, has failed to apply art which teaches or suggests the invention as claimed, has failed to properly construe the applied art, and has failed to consider all recited claim limitations.

1. THE EXAMINER HAS FAILED TO ESTABLISH A PRIMA FACIE CASE

The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); In re Piasecki, 745

F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

The limitations required by the claims cannot be ignored. See In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). All claim limitation, including those which are functional, must be considered. See In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

The Examiner must provide sufficient factual basis or rationale as to how features of the invention recited in the claims are taught or suggested in the applied art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). That is, objective evidence must be presented by the Examiner in support of the rejection. Without such support, the rejection is improper per se.

Claims 34-38, 40-47, and 49-53 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hogan. Claims 39-48 stand rejected under 35 U.S.C. § 103(a) as obvious over Hogan in view of Bezos.

It is respectfully submitted that the Examiner has failed to establish a prima facie case for the rejection. More particularly, the Examiner has failed to provide objective support or reasonable rationale for the rejections, has ignored limitations recited in the claims, and has applied art in a manner inconsistent with its teachings.

Independent claim 34 requires, at least in part, a transmission of a notice according to an e-mail protocol that indicates the availability of billing information, a transmission of a request, in response to the notice and according to a protocol other than an e-mail protocol, to receive the billing information, and a transmission of at least a portion of the billing information in response to the request.

Independent claim 50 requires, at least in part, a first network server for transmitting a bill availability notice via an e-mail protocol, and a second network server for receiving, via a protocol other than e-mail, a request to receive the bill. The bill is transmitted to a payer in response to the received request. The Examiner rejected claims 34 and 50 upon the same grounds.

As discussed above, Hogan discloses two embodiments of an electronic bill presentment service. In both embodiments, a bill image is received from a biller and formatted for presentation (see, for example, column 4, lines 53-67, column 5, lines 53-57, and column 9, lines 50-53). In the first embodiment, a subscriber retrieves the stored billing information from the bill service via the World Wide Web (see, for example, column 2, lines 32-35), and in the second embodiment, the stored billing information is transmitted to the subscriber as an e-mail message by the bill service (see, for example, column 2, lines 48-50).

The Examiner points to column 5, lines 53-61, of Hogan as teaching the transmission of a notice of bill availability according to an e-mail protocol. The Examiner-referenced text discloses transmitting an e-mail message to a subscriber only

if both of two conditions are met. According to Hogan, this e-mail will only be sent if the subscriber has not logged on to the bill service **and** a bill is due within a predetermined period of time. Thus, the Examiner-referenced text does not disclose an e-mail notice of availability of billing information, but rather discloses a notice sent to inform a subscriber of a pending bill due date, i.e., it is sent if there is a danger that a bill might not get paid on time.

Furthermore, Hogan is silent as to any activity that may or may not occur after the transmission of this e-mail. Thus, Hogan also does not teach or suggest transmission of a request for billing information in response to a notice of availability of billing information, or transmission of at least a portion of the billing information in response to receipt of the request, as required by claims 34 and 50.

Hogan does not disclose what an contents of the e-mail transmitted if both a subscriber has not logged on and a bill is due might be. The Examiner argues that the bill service transmitted e-mail contains a URL of the bill service. However, Hogan simply does not disclose this. Hogan does disclose, in column 3, lines 44-46, a URL of the bill service being sent to a subscriber via a different type of e-mail. This different e-mail transmission relates to the subscriber enrolling with the bill service, not to the e-mail Hogan transmits if both a subscriber has not logged on to the bill service and a bill is due within a predetermined time period. The URL is sent to the subscriber to inform him or her how to access the bill service via the World Wide Web. In other words, a welcome e-mail. It should be noted, though, that neither claim 34 nor 50 requires that a

notice of availability sent via an e-mail include a URL.

In the final Official Action, the Examiner argues, pointing to column 5, line 62, through column 6, line 31, "it seems that the e-mail received contains certain information on the bill that is due and instruct [sic] the customer on how to access the bill payment data through server computer 160 in order for the customer to receive additional information on the bill that is due by instructing the customer to log into the EBSC's bill payment website." As best understood, the Examiner seems to acknowledge that the relied upon e-mail notice is a payment due notice, not a billing information availability notice, as required by the present claims. However, the Examiner continues to rely upon this feature of Hogan in rejecting these claims and seems to have ignored the traversal arguments of the Amendment. Thus, it seems that the Examiner has ignored the requirement that the e-mail notice be a notice billing information availability.

Discussed above, independent claim 50 requires a first network server and a second network server. The Examiner, in responding to traversal arguments, makes the statement "Hogan clearly teaches an e-mail server in addition to server computer 160" (paper no. 13, page 8, section 6). However, the Examiner fails to point to any portion of Hogan, text or figures, in support of this conclusionary statement. As discussed above, Hogan only disclose a single server (detail 160) for all communications with subscribers.

Thus, Hogan does not teach or suggest an e-mail protocol notice indicating

availability of billing information or a bill, a request for the billing information or bill responsive to the notice transmitted via a protocol other than e-mail, and a transmission of at least a portion of the billing information or the bill in response to the request.

Independent claim 40 requires, at least in part, transmission of an e-mail notice of availability of billing information, transmission of an e-mail request for the billing information in response to the notice, and transmission of billing information in response to the request.

Independent claim 51 requires, at least in part, a memory for storing billing information, and a processor for transmitting an e-mail notice of availability of a bill, and for receiving a request via e-mail for the available bill. The Examiner rejected both claims 40 and 51 upon the same grounds in both the first and the final Official Actions: Figures 1, 10, 11, and column 9, lines 7-19 and 61-64

Introduced above, Hogan discloses two embodiments. In the first, billing information is delivered to a subscriber via a protocol other than e-mail, and notice of a pending bill due date is delivered to a subscriber via an e-mail protocol (or by regular mail) only if a bill is due within a certain time frame. In the second embodiment, billing information is delivered to a subscriber via an e-mail protocol, and a notice of a pending bill due date is delivered to a subscriber via regular mail (not electronically), only if a bill is due within a certain time frame. The subscriber never requests billing information in the second (e-mail) embodiment, as the billing information is ALWAYS pushed to the subscriber via e-mail. The Examiner-referenced portions of Hogan are directed to the

second embodiment.

The Examiner relies upon Figure 1 and column 9, lines 7-19, for teaching of transmission of the e-mail notice, to column 9, lines 61-64, for teaching of transmission of the e-mail request, and to Figures 10 and 11 for teaching of the transmission of billing information. In the Amendment of August 13, 2003 it was pointed out that Figure 1 shows a subscriber's computer (detail 100) in communication with a bill service computer (detail 160) via the Internet and the bill service computer in communication with a bill capture device (detail 150), which is in communication with multiple payee (biller) computers (details 107-1 through 107-k). It was also pointed out that Figure 10 depicts a user presentation of unopened and unpaid bills transmitted to a subscriber via e-mail, and Figure 11 depicts a user presentation of a bill transmitted to a subscriber via e-mail.

Furthermore, applicants noted that the column 9, lines 7-19 text, again which is directed to the second Hogan embodiment, discloses the bill service transmitting an e-mail message that includes formatted bill data. As disclosed in column 9, lines 50-54, of Hogan, the bill service receives billing data from a payee, formats the billing data in the form of an e-mail, and then transmits the e-mail (bill) to the subscriber's e-mail address. Thus, this e-mail is not a notice of availability of billing information, as required by claims 40 and 51, but rather **the billing information itself**.

The Examiner points to column 9, lines 61-64, as disclosing the required transmission of the e-mail request. This Examiner-referenced text discloses that

whenever a subscriber opens an e-mail to view a bill, an acknowledgement message is transmitted to the bill service indicating such. This acknowledgement message is transmitted "[u]tilizing a standard receipt confirmation feature of the e-mail service" (column 9, lines 61-62). This acknowledgement message is in no way an e-mail request to receive available billing information, as required by claims 40 and 51. This is especially true in light of the fact that billing information has already been delivered to the subscriber as an e-mail message prior to transmission of the acknowledgement message, which itself can only be transmitted after a subscriber opens the e-mail containing the billing information. In other words, this confirmation message is automatically sent whenever a subscriber opens an e-mail which already contains billing information. Hogan simply does not teach or suggest a request for billing information in association with the e-mail embodiment.

Finally, the Examiner points to Figures 10 and 11 as disclosing the transmission of billing information in response to the request. In the Amendment it was pointed out that Figures 10 and 11 are each representations of information that can be displayed on a subscriber's computer after billing information has been transmitted to the subscriber via e-mail, not transmissions of billing information in response to a request for that billing information. It was respectfully requested that the Examiner clarify her position in relying upon Figures 10 and 11 for this feature. The Examiner, in the final Official Action, failed to not only clarify her position regarding Figures 10 and 11, but also failed to address other traversal arguments regarding claims 40 and 51. Thus, the Examiner

has provided no rational basis for the rejection of claims 40 and 51.

As should be understood from the above, Hogan does not teach or suggest an e-mail notice of availability of a bill or billing information, an e-mail request for the billing information or bill responsive to the notice, and transmission of at least a portion of the billing information or the bill in response to the request.

Independent claim 43 requires, at least in part, transmission of a notice indicating availability of billing information transmitted according to a network protocol other than e-mail, transmission of a request to receive the billing information transmitted responsive to the notice and also transmitted according to a network protocol other than e-mail, and a transmission of billing information responsive to the request.

Independent claim 52 requires, at least in part, a memory for storing billing information and at least one processor for transmitting, via a network protocol other than e-mail, a billing information availability notice, and to receive a request, also via a network protocol other than e-mail, a request for the billing information. The Examiner rejected claims 43 and 52 upon the same grounds.

The Examiner relies upon Hogan's Figure 3 and column 6, lines 9-16, as teaching transmission of a notice of availability of billing information according to a network protocol other than an e-mail protocol, upon column 5, line 62, through column 6, line 30, of Hogan as teaching transmission of a request, according to a network protocol other than an e-mail protocol, to receive the billing information responsive to the notice, and to column 6, lines 11-30, of Hogan as teaching transmission of the billing

information in response to the request.

Figure 3 depicts a home page of the bill service presented via the World Wide Web in accordance with the first Hogan embodiment. The home page includes links to separate user interfaces for performing certain functions, such as obtaining account balances (detail 201), receiving and paying bills (detail 203), and selecting new payees (detail 205). Figure 3 shows, at detail 203, a link to a user presentation for receiving and paying bills. Detail 203 is the only detail of Figure 3 that relates to bills.

The Examiner, in responding to traversal arguments included in the Amendment, argues that "detail 203 links the user to the available billing information. ... The Examiner asserts that a notice is merely used to bring attention to a particular subject. In Figures 3 all the detail items 201, 203, 205, 207, 209, and 211 are all notices or subject which are brought to the user's attention. By allowing the user to receive and pay bills (detail 203) the system is in fact bringing to the user's attention the billing information available.

In order for this link to be a notice of available billing information this link would have to be selectively displayed, i.e., only presented when billing information is available. Hogan in no way teaches or suggests that this link is selectively presented. Rather, with reference to column 4, lines 14-22, Hogan teaches that the details of the home page of Figure 3 are always displayed. In particular, Hogan teaches that the home page "furnishes information about the service offered by the provider through use of graphic images, sound, hyperlink choices, etc. With that information, the user is

guided through the home page to select the service and desired service features" (column 4, lines 17-22). Thus, Hogan in fact teaches against the home page of Figure 3 being a notice of available billing information, as detail 203 "receive and pay bills" is always present, irrespective of billing information being available.

The Examiner also argues that Hogan teaches transmitting a request, via a protocol other than an e-mail protocol, to receive available billing information responsive to a notice of availability of billing information. This is not supported by the Examiner-referenced text. Rather, column 5, line 62, through column 6, line 30, discloses a subscriber requesting access to a "receive and pay bills" user interface. As should be understood from the discussion above, this access request is not made in response to a notice of availability of billing information. Rather, this access request is made from a home page of the bill service through which the subscriber is presented multiple service options.

In summary regarding the independent claims, Hogan discloses two embodiments of a bill presentment system. One embodiment is a "pull" embodiment whereby a subscriber retrieves billing related information from the system. That is, a subscriber must request presentment of each and every bill presented via the system. This request is via a protocol other than e-mail. In this one embodiment, if a subscriber has not requested presentment, and a bill is due within a certain time frame, an e-mail or regular mail notice is delivered to the subscriber informing him or her that a bill's due date is approaching. Thus, this embodiment includes an e-mail protocol notice (or

regular mail notice) of a bill's due date being delivered to a subscriber under only one specific set of circumstances (presentment of the bill not having been requested by the subscriber, and payment of the bill being due within a certain time frame).

The other embodiment is a "push" embodiment whereby the system always presents bill related information to a subscriber without that subscriber requesting the information. That is, billing information, for every bill, is e-mailed to the subscriber. If a particular bill, which has already been pushed to a subscriber via e-mail, is due within a certain time frame and has not been paid, the system delivers, via regular mail, a notice that the bill's due date is approaching. Thus, this embodiment includes a regular mail notice of a bill's due date being delivered to a subscriber under only one specific set of circumstances (the bill having already been delivered to the subscriber via e-mail, and payment of the bill still being due within a certain time frame).

Regarding claims 35, 41 and 44, the Examiner argues in the first Official Action that Figure 11 discloses the required formatting of billing information for presentation in response to receipt of a request for the billing information. Figure 11 merely is depicts an electronic bill presented via e-mail, as described at column 3, lines 33-34, and column 11, lines 16-25.

In the Amendment applicants argue that Hogan clearly teaches that billing information (bill image) is formatted as soon as it is received from a biller (see column 5, lines 53-57, and column 9, lines 16-25). In no way does Hogan teach or suggest formatting in response to a subscriber's request to receive the billing information. In the

first embodiment, formatted billing information is stored for eventual access by a subscriber (stored until pulled). In the second embodiment, formatted billing information is e-mailed to a subscriber (pushed to) upon completion of the formatting.

In responding to this, the Examiner argues, pointing to column 5, line 62, through column 6, line 31, "the claim doesn't recite that the bill is formatted on the fly. The claim limitation is met by Hogan because in Hogan the user receives an e-mail reminder of the bill that is due and the user is instructed to visit the EBSC website and based on the user requesting the bill information from the website the bill is presented to the user." While the Examiner is correct in noting that the claims do not recite "on the fly", what this has to do with formatting in response to a request for billing information is not understood. The Examiner-referenced text does not even address formatting, and the Examiner has seemingly ignored those sections of Hogan that do. It seems that the Examiner has completely ignored the express limitations of these claims, as well as the traversal arguments of the Amendment.

Claims 37 and 46 require that a notice of availability of billing information include information indicating a location of the available billing information on a network. Claims 38 and 47 require that the location information be a hyper-link selectable to cause transmission of the request. The Examiner continues to rely upon column 4, lines 14-22, and column 5, line 44, through column 6, line 30, for the requirements of these claims.

The column 4 text is a general discussion of internet home pages and navigation

with home pages. This simply does not teach or suggest the claim requirements. The column 5 and 6 text discloses, as discussed above, a delivery of a URL of the bill service to a subscriber via e-mail as a part of registration for service. This e-mail is not a notification of available billing information. AS discussed in column 6, lines 10-21, this URL points to a home page associated with the bill service. From this home page, a subscriber then must access another Web page for presentation of billing information (see Figure 3). Hogan in fact teaches against a notice of bill availability including a location identifier of available billing information, as the only location identifier disclosed (the URL of the bill service) directs a subscriber to a general home page, not billing information. The Examiner has yet to point to any portion of Hogan that teaches or suggests a notice of availability indicating a location of available billing information, yet alone such location information being a hyper-link.

Claims 39 and 48, rejected under the Hogan/Bezos combination, require the billing information location information hyper-link to be an icon. Bezos discloses a hyper-link to a merchant Web-site being an icon. This merchant icon in no way teaches or suggests the location of available billing information.

In view of the above, it is respectfully submitted that the Examiner has failed to establish a prima facie basis for the rejection of the pending claims.

2. THE APPLIED REFERENCE FAILS TO TEACH OR SUGGEST THE CLAIMED INVENTION

Anticipation, under 35 U.S.C. §102, requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. Although anticipation requires only that the claim under attack "read on" something disclosed in the reference, all limitations of the claim must be found in the reference, or "fully met" by it. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

Inherency requires certainty, not speculation. In re Rijckaert, 9 F.3rd 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); In re Wilding, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). Objective evidence must be relied upon to defeat the patentability of the claimed invention. Ex parte Natale, 11 USPQ2d 1222 (BPAI 1988).

In rejecting claims under 35 U.S.C. 103(a), it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. Stratoflex, Inc. v. Aeroquip Corp., 218 USPQ 871 (Fed. Cir. 1983); In re Warner, 154 USPQ 173 (CCPA 1967). It also is incumbent upon the Examiner to provide a basis in fact and/or cogent technical reasoning to support the conclusion that one having ordinary skill in the art would have been motivated to combine references to arrive at a claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 USPQ2d 1434 (Fed. Cir. 1988). In so doing, the Examiner is required to make the factual determinations set forth in Graham v. John Deere Co. of

Kansas City, 148 USPQ 459 (1966), and to provide a reason why one having ordinary skill in the art would have been led to modify the prior art reference to arrive at the claimed invention. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 227 USPQ 657 (Fed. Cir. 1985).

Such a reason must stem from some teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley, 5 USPQ2d 1434 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 227 USPQ 657 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929 (Fed. Cir. 1984); In re Sernaker, 217 USPQ 1 (Fed. Cir. 1983). Inherency requires certainty, not speculation. In re Rijckaert, 28 USPQ2d 1955 (Fed. Cir. 1993); In re King, 231 USPQ 136 (Fed. Cir. 1986); W. L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983); In re Oelrich, 212 USPQ 323 (CCPA 1981); In re Wilding, 190 USPQ 59 (CCPA 1976). Objective evidence must be relied upon to defeat the patentability of the claimed invention. Ex parte Natale, 11 USPQ2d 1222 (BPAI 1988).

In determining obviousness, the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed. Hartness Int'l, Inc. v. Simplimatic Eng'g Co., 2 USPQ2d 1826 (Fed. Cir. 1987). It is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In

re Wesslau, 147 USPQ 391 (CCPA 1951). Piecemeal reconstruction of prior art patents is improper, In re Kamm, 172 USPQ 298 (CCPA 1972). The Examiner must give adequate consideration to the particular problems and solution addressed by the claimed invention. Northern Telecom, Inc. v. Datapoint Corp., 15 USPQ2d 1321 (Fed. Cir. 1990); In re Rothermel, 125 USPQ 328 (CCPA 1960).

The fact that the prior art could be modified so as to result in the combination defined by the claims does not make the modification obvious unless the prior art suggests the desirability of the modification. In re Deminski, 230 USPQ 313 (Fed. Cir. 1986). The test is what the combined teachings would have suggested to those of ordinary skill in the art. In re Keller, 208 USPQ 817 (CCPA 1981). Simplicity and hindsight are not proper criteria for resolving obviousness, In re Warner, supra. Furthermore, as the Federal Circuit recently reiterated, reliance on common knowledge and/or common sense also cannot be the basis of finding obviousness (See In re Lee, 61 USPQ 2d 1430 (Fed. Circ. 2002)). The deficiencies in the applied art cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sensible.

The proper approach to the issue of obviousness is whether the hypothetical person of ordinary skill in the art, familiar with the references, would have found it obvious to make a structure corresponding to what is claimed. In re Keller, 208 USPQ 871 (CCPA 1981); In re Sernaker, 217 USPQ 1 (Fed. Cir. 1983). Hindsight obviousness after the invention has been made is not the test. In re Carroll, 202 USPQ 571 (CCPA 1979). The

reference, viewed by itself and not in retrospect, must suggest doing what applicant has done. In re Shaffer, 108 USPQ 326 (CCPA 1956); In re Skoll, 187 USPQ 481 (CCPA 1975).

Again, the issue is not whether it is within the skill of the artisan to make the proposed modification but, rather, whether a person of ordinary skill in the art, upon consideration of the references, would have found it obvious to do so. The fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification. See In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984), In re Deminski, 230 USPQ 313 (Fed. Cir. 1986), In re Keller, supra. and In re Laskowski, 10 USPQ2d 1397 (CAFC 1989).

As discussed above in detail, the applied prior art fails to teach or suggest the limitations any of the independent claims. In particular, Hogan (nor Bezos) does not teach or suggest a method for presenting billing information including transmitting a notice according to an e-mail protocol via a network that indicates availability of billing information, transmitting a request according to a protocol other than an e-mail protocol via the network in response to a receipt of the notice, and transmitting at least a portion of the billing information via the network in response to the request, as required by claim 34.

Also, the applied art does not teach or suggest the requirements of claim 40 of transmitting an e-mail notice via a network indicating availability of billing information,

transmitting an e-mail request, via the network, to receive the billing information in response to the notice, and transmitting, via the network, at least a portion of the billing information in response to the request.

The requirements of claim 43 are likewise not taught or suggested by the applied prior art. That is, the applied prior art does not teach or suggest transmitting, via a network and according to a network protocol other than e-mail, a notice indicating availability of billing information, transmitting, via the network and also according to a network protocol other than e-mail, a request to receive the billing information, and transmitting via the network at least a portion of the billing information in response to receipt of the request.

The requirements of independent claim 50 of a bill presentment network including a first network server and a second network server are also not taught or suggested, the first network server transmitting, via an e-mail protocol, a notice to a payer indicating availability of a bill and the second network server receiving from the payer, via a protocol other than e-mail, a request to receive the bill.

The applied art also does not teach or suggest the requirements of independent claim 51 of a system for bill presentment including a memory for storing billing information and a processor for transmitting a notice to a payer, via e-mail, indicating availability of a bill, and receiving a request from the payer via e-mail for the available bill, the request transmitted in response to receipt of the notice, and the bill transmitted to the payer 120a in response to receipt of the request.

And still again, the requirements of independent claim 52, of a system for bill presentment including a memory storing billing information and at least one processor transmitting, via a network protocol other than an e-mail protocol, a notice to a payer indicating availability of billing information, and receiving, via a network protocol other than an e-mail protocol, a request from the payer to receive the billing information, the request is transmitted in response to receipt of the notice, and the bill transmitted to the payer in response to receipt of the request, are not taught or suggested by the applied art.

Also, the applied art does not teach or suggest the requirements of dependent claims 35, 41, and 44 that the billing information be formatted for presentation in response to receipt of a request.

And, as recited in dependent claims 37 and 46, the notice including information indicating a location of the available billing information on the network is neither taught or suggested by the applied art.

Dependent claims 38 and 47 requirements that the location information be a hyper-link that is selected to cause transmission of the request, as well as the requirement of claims 39 and 48 that the hyper-link be an icon, are also not taught or suggested by the applied art.

As will be understood from the discussion above, Hogan merely discloses an electronic notice of a pending bill due date when a subscriber has not accessed the bill presentment service and a payment is due within a certain time frame. And, Hogan

discloses a regular mail notice of a pending bill due date when a bill has already been electronically delivered to a subscriber, the subscriber has not paid the bill, and the bill is due within a certain time frame. Bezos discloses an icon for accessing a merchant web site.

In view of the above, it is respectfully submitted that Hogan, Bezos, or a combination thereof, fails to teach or suggest the invention as recited in the pending claims.

CONCLUSION

It is respectfully submitted that the Examiner (i) has failed to establish a prima facie case for the rejections, (ii) failed to reasonably construe that which is taught and suggested by the applied prior art, (iii) has failed to apply art which teaches or suggests the claimed invention, (iv) ignored features explicitly required by claims, and (v) applied art in a manner inconsistent with it teachings.

Thus, it is respectfully submitted that the rejection of the pending claims over the applied prior art is improper.

In summary, Applicants respectfully submit that the applied references do not teach or suggest features recited in each of the independent claims, as well as features recited in the dependent claims, and the Examiner has failed to provide reasonable evidence to support a contrary conclusion. Accordingly, it is submitted that the art does

not provide any teaching, or suggest, within its teachings, which would lead to the features or advantages of the instant invention, and the claims patentably define over the art.

The rejection of the ending claims is in error, and reversal is clearly in order and is courteously solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully Submitted,
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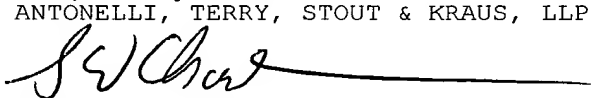

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APPENDIX OF CLAIMS UNDER APPEAL

34. (previously presented) A method for presenting billing information via a network, comprising:

transmitting a notice according to an e-mail protocol, via a network, indicating availability of billing information;

transmitting a request according to a protocol other than an e-mail protocol, via the network, to receive the billing information responsive to receipt of the notice; and

transmitting at least a portion of the billing information, via the network responsive to receipt of the request.

35. (Previously Presented) The method of claim 34, further comprising:

formatting the billing information for presentation responsive to receipt of the request.

36. (Previously Presented) The method of claim 34, further comprising:

formatting the billing information for presentation prior to transmitting the notice; and

storing the formatted billing information;

wherein the transmitted billing information is the stored formatted billing information.

37. (Previously Presented) The method of claim 34, wherein the notice includes information indicating a location of the available billing information on the network.

38. (Previously Presented) The method of claim 37, wherein the information indicating a location of the available billing information is a hyper-link, further comprising:

selecting the hyper-link to transmit the request.

39. (Previously Presented) The method of claim 38, wherein the hyper-link is an icon.

40. (Previously Presented) A method for presenting billing information, comprising:

transmitting, via a network, an e-mail notice indicating availability of billing information;

transmitting, via the network, an e-mail request to receive the billing information responsive to receipt of the notice; and

transmitting, via the network, at least a portion of the billing information responsive to receipt of the request.

41. (Previously Presented) The method of claim 40, further comprising:

formatting the billing information for presentation responsive to receipt of the

request.

42. (Previously Presented) The method of claim 40, further comprising:

formatting the billing information for presentation prior to transmitting the notice; and

storing the formatted billing information;

wherein the transmitted billing information is the stored formatted billing information.

43. (Previously Presented) A method for presenting billing information, comprising:

transmitting, via a network, a notice indicating availability of billing information, the notice transmitted according to a network protocol other than e-mail;

transmitting, via the network, a request to receive the billing information responsive to receipt of the notice, the request transmitted according to a network protocol other than e-mail; and

transmitting, via the network, at least a portion of the billing information responsive to receipt of the request.

44. (Previously Presented) The method of claim 43, further comprising:

formatting the billing information for presentation responsive to receipt of the request.

45. (Previously Presented) The method of claim 43, further comprising:

formatting the billing information for presentation prior to transmitting the notice; and

storing the formatted billing information;

wherein the transmitted billing information is the stored formatted billing information.

46. (Previously Presented) The method of claim 43, wherein the notice includes information indicating a location of the available billing information on the network.

47. (Previously Presented) The method of claim 46, wherein the information indicating a location of the available billing information is a hyper-link, further comprising:

selecting the hyper-link to transmit the request.

48. (Previously Presented) The method of claim 47, wherein the hyper-link is an icon.

49. (Previously Presented) The method of claim 43, wherein the notice and the request are each transmitted according to a same network protocol other than e-mail.

50. (Previously presnted) A bill presentment network, comprising:

a first network server configured to transmit, via an e-mail protocol, a notice to a payer indicating availability of a bill; and

a second network server configured to receive from the payer, via a protocol other than an e-mail protocol, a request to receive the bill, the request transmitted responsive to receipt of the notice;

wherein the bill is transmitted to the payer responsive to receipt of the request.

51. (Previously Presented) An system for bill presentment, comprising:

a memory configured to store billing information; and

a processor configured to transmit a notice to a payer via e-mail indicating availability of a bill and to receive a request from the payer via e-mail for the available bill;

wherein the request is transmitted responsive to receipt of the notice; and

wherein the bill is transmitted to the payer responsive to receipt of the request.

52. (Previously Presented) A system for bill presentment , comprising:

a memory configured to store billing information; and

at least one processor configured to transmit, via a network protocol other than an e-mail protocol, a notice to a payer indicating availability of billing information, and to receive a request, via a network protocol other than an e-mail protocol, from the payer to receive the billing information;

wherein the request is transmitted responsive to receipt of the notice; and

wherein the bill is transmitted to the payer responsive to receipt of the request.

53. (Previously Presented) The system of claim 52, wherein the notice and the request are each transmitted according to a same network protocol other than an e-mail protocol.